REMARKS

In the application claims 1-10 remain pending. Claims 11-19 have been canceled without prejudice. It is respectfully requested that the amendment be entered into the record of the subject application in keeping with 37 C.F.R. § 116(b) in that the amendment only cancels claims for the purpose of placing the claims in better form for consideration on appeal should such action be necessary.

The reconsideration of the rejection of the claims is respectfully requested.

The cancellation of claims 11-19 has rendered moot the rejection of claims 17-19 under 35 U.S.C. § 112 and the rejection of claims 11 and 14-19 under 35 U.S.C. § 103. It is respectfully requested that these rejections now be withdrawn.

Pending claims 1-10 stand rejected under 35 U.S.C. § 103 as being rendered obvious by Pariente (WO 9409570) as modified by Renner (5679945). In rejecting the claims it was acknowledged that Pariente fails to disclose, teach, or suggest the claimed readable media wherein the readable media has stored thereon access data that is modifiable by the remote control for the purpose of limiting use of code data (also stored on the readable media). It was, however, asserted that Renner teaches an intelligent card reader in which "the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date." Thus, the Office Action concluded that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Pariente card can be used in order to prevent unauthorized use of the card to protect against unauthorized use."

In response to this rejection of the claims it is respectfully submitted that Renner fails to disclose, teach, or suggest modifying Pariente to arrive at the invention claimed. Specifically, like Pariente, **nothing from Renner expressly or inherently describes, teaches, or suggests the desirability of providing a readable media that has stored**

thereon access data <u>that is modifiable <u>by a remote control</u></u> for the purpose of limiting use of code data that is <u>also</u> read from the readable media by the remote control. Since neither Pariente nor Renner disclose, teach, or suggest these claimed elements, it is respectfully submitted that the disclosure within Pariente and Renner cannot be said to support a *prima facie* case of obviousness.

Turning now to Renner, Renner describes a system for limiting access to physical locations that are under the control of an intelligent card reader ("ICR"). Contrary to the position taken in Office Action, <u>the ICR of Renner is not a card</u>. Rather, Renner plainly states that <u>a card is inserted into the ICR</u>. (Col. 11, line 17). Furthermore, Renner plainly states that the card inserted into the ICR stores nothing more than a static key value. (Col. 11, lines 17-22). Yet further, Renner plainly states that once the static key value is read from the card by the ICR, the ICR (*and not the card as set forth in the Office Action*) may be programmed to use the read key value to control parking garage gates or other types of entry-inhibiting devices such as safes or file cabinets, to make access contingent on other parameters such as the time of day or day of week, or to control access to a number of times or a preprogrammed expiration date. (Col. 11, lines 30-35).

From the foregoing it is submitted that the plain language of Renner discloses, teaches, and suggests nothing more than a system in which a card reader (ICR) is programmed to use a static key value read from a card to limit access to a physical location. In Renner it is the card reader <u>and not the card</u> (which only maintains a simple, static key value) that is programmed with limitations such as the number of times the card can be used or an expiration date. Thus, since Renner discloses, teaches, and suggests nothing more than a card that has stored thereon a static key value that is only read by the ICR, Renner cannot be said to disclose, teach, or suggest the desirability of a system in which data stored on a card <u>is modified by a device which reads the card, e.g., a remote control</u>, let alone for the

purpose of limiting use of <u>other</u> data read from the card (of which there is none in the system of Renner, i.e., the card of Renner <u>only</u> stores a key value).

In sum, since neither Pariente nor Renner disclose, describe, teach, or suggest, either expressly or inherently, a card that has stored thereon data <u>that is modifiable by the reading device</u>, i.e., remote control, for the purpose of limiting use of <u>other</u> data that is also stored on the smart card and read by the reading device as is set forth in the claims, the combination of Pariente and Renner cannot be said to establish a *prima facie* case of obviousness. For this reason, it is submitted that the rejection of claims 1-10 must be withdrawn.

It is still further respectfully submitted that Renner, which addresses the problem associated with how to limit access to physical locations, i.e., parking garages, safes, etc., is clearly non-analogous art and, therefore, not suitable for use in determining the obviousness of the invention claimed. In this regard, it is well settled that "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). With respect to the first criteria used to determine relevance of a prior art reference it cannot be argued that the programmable card reading lock disclosed within Renner is in the field of remote controls. This is evidenced by, among other things, the USPTO classifications of Renner as compared to the USPTO classifications of the subject application for patent. With respect to the second criteria used to determine relevance of a prior art reference, it is submitted that the disclosure within Renner would not have commended itself to the inventor's attention in considering the problem the subject invention solves, i.e., the problem solved by the subject invention has nothing to do with using a key to limit access to physical

locations via a programmable key accepting lock. Thus, for the reason that Renner is non-analogous art it is respectfully submitted that the rejection of the claims must be withdrawn. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories and since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories.)

It is additionally submitted that a *prima facie* case of obviousness has not been presented for any of dependent claims 2-10. In this regard, the Office Action fails to set forth where either Pariente or Renner disclose the elements set forth in these claims, considering each and every word. For example, the Office Action never asserts that either Pariente or Renner discloses, teaches, or suggests code data stored on a readable media that is limited in use by means of access data wherein the code data specifically: 1) functions to add codes to the remote control; 2) functions to allow remote control access to limited-access programming; 3) functions to allow timed access to limited-access programming; 4) functions to allow a predetermined number of accesses to limited-access programming; 5) functions to enable access to a code stored within the remote control; 6) functions to associate command codes within buttons of the remote control; or 7) functions as data representative of a channel line-up of a broadcast service provider. Since the burden of presenting a *prima facie* case of obviousness with respect to claims 2-10 has not been met, the rejection of claims 2-10 must be withdrawn.
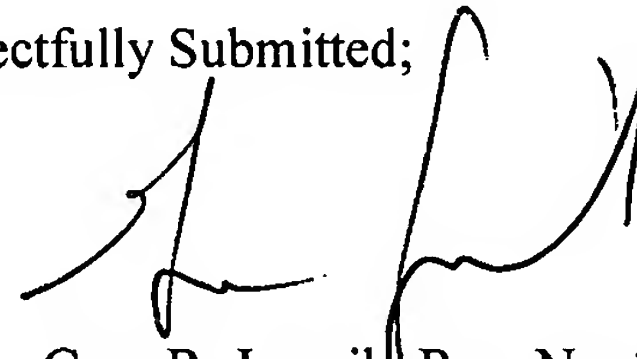
CONCLUSION

It is respectfully submitted that claims 1-10 are in condition for allowance.

Should it be determined that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner authorized to charge any fee deficiency to deposit account number 50-2428.

Respectfully Submitted;

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